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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Moshe Levnat

Application No.: 10/719,622

Filed: November 21, 2003

For: STAINLESS STEEL UNSEALED
MOTOR

Examiner: Not yet assigned

Art Unit: Not yet assigned

Attorney Docket No.: 847-072

PETITION UNDER 35 USC §118, 37
C.F.R. §1.47(b), and 37 C.F.R. §1.17(a)(1)

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Notice of Missing Parts of Non-Provisional Application mailed from the United States Patent and Trademark Office on March 8, 2004, after a diligent but unsuccessful attempt to have the above-named inventor sign a Declaration, the party in interest, Cleveland Motion Controls (hereinafter "CMC"), to whom it is believed the inventor owes a duty to assign the invention wishes to file a response including this PETITION UNDER 35 USC §118 and 37 C.F.R. §1.47(b) to make application for patent on behalf of and as agent for the inventor. Applicants believe that a fee of \$130.00 under 37 CFR §1.17(h) is required for submission of this petition.

Applicants hereby also PETITION FOR A ONE MONTH EXTENSION OF TIME to respond to the Notice, and believe that a fee of \$110.00 under 37 CFR §1.17(a) is required therefore. A check for the amount of \$240.00 is enclosed herewith. However, if additional fees are required, the Director is authorized to deduct such fee from the undersigned's Deposit Account No. 50-0289, or credit any overpayment to the same Deposit Account.

Legal Analysis:

35 U.S.C. §118 and 37 C.F.R. §1.47(b) are the applicable law when a sole inventor refuses to sign a patent application. 35 U.S.C. §118 is reproduced hereinbelow:

35 U.S.C. 118 Filing by other than inventor.

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

Based on the facts recited in the Declaration of E. Wayne Foley, President of CMC, which Declaration is submitted herewith, a diligent effort has been made to obtain Mr. Levnat's signature on a Declaration for the present application. Mr. Levnat has refused to sign. The facts of Mr. Levnat's employment relationship with CMC are also described in the Declaration of E. Wayne Foley, and are supported by the documents submitted therewith.

National Development Company v. Gray, 316 Mass. 240, 55 N.E.2d 783, 62 USPQ 205, 153 A.L.R. 973 (1944), is the leading Massachusetts Supreme Judicial Court decision finding an employment relationship deemed to be one where the employee was obliged to assign in the absence of a written agreement. In *National Development Company v. Gray*, the employee developed a new machine as part of his employment duties. The Massachusetts Supreme Judicial Court found that the employee was obliged to assign his invention to his employer because he was hired to develop and perfect the employer's machine, even though he had not signed an agreement and even though he made the drawings at home on his own time during the term of his employment as an employee at will. A copy of *National Development Company v. Gray* is attached hereto.

After *Erie v. Thompkins*, 304 U.S. 64, 58 S.Ct. 817 (1938), federal courts are required to apply state common law if there is no applicable Federal law or US Constitutional provision that defines the law. Contract law, including agreements as to conveyance of rights in inventions, whether explicit or not, are therefore controlled by state law. Since Mr. Levnat worked in Massachusetts at the time of making his invention, it appears that Massachusetts common law as regards contracts should control, and the SJC opinion in *National Development* will be accepted as the law in either state or federal court.

Other federal court cases, such as *Standard Parts Co. v. Peck*, 264 U.S. 52, 44 S.Ct. 239 (1924) (pre-Erie), or *Teets v. Chromalloy Gas Turbine Corp.*, 38 USPQ2d 1695 (Fed. Cir. 1991) hold as does *National Development*. Neither of these cases took place in Massachusetts, but they are among the more frequently cited cases.


Mr. Levnat is identified as the sole inventor of the above-identified application. From the facts, it appears that he was hired specifically to "Perform electro-magnetic design and development of all Servo motors." When his design and development efforts, for which he was paid a salary, resulted in a potentially patentable improvement, he was obliged, under the applicable Massachusetts law, to assign his invention to his employer. Additionally, as indicated above, Mr. Levnat does not contest this obligation to assign, but refuses to sign because he feels that his compensation has not been adequate.

Mr. Foley, as President of CMC, respectfully submits in his Declaration that failure to permit the above-identified patent application to be prosecuted because of the refusal of Mr. Levnat to sign both a Declaration and Power of Attorney and an Assignment will irreparably damage the intellectual property rights of CMC to the extent that one or more patents may ultimately be granted upon the above-identified application and/or one or more of continuation applications, divisional applications, continuation-in-part applications and/or international or foreign applications claiming priority to the above-identified application.

PETITION Under 35 USC §118
U.S.S.N. 10/719,622
Filed: November 21, 2003
First Named Inventor: Moshe Levnat

CMC therefore respectfully **PETITIONS** the Director of the United States Patent and Trademark Office to grant it standing to prosecute through its undersigned representative the above identified patent application, and to have issued in its name any and all Letters Patent that may issue from the present application, and from any continuations, continuations-in-part, divisionals or other applications claiming the priority and the benefit of the present application.

Respectfully submitted,



Joseph B. Milstein, Ph.D.
Reg. No. 42,897

Date: May 25, 2004

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